

REMARKS

Claims 24, 26, 28-38, 40-49, 51 and 52 are pending in the application. Claims 24, 26, 28-38, 40-49, 51 and 52 are rejected. No claims are allowed. No claim amendments are presented.

Claim Rejections – 35 U.S.C. § 103

Claims 24, 26, 28-38, 40-43 and 51-52

Claim 24, 26, 28-38, 40-43 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO0010510 (corresponding to U.S. Patent No. 6562876) (Ansmann) in view of U.S. Pat. Appln. Pub. No. 2003/0161801 (Yamasaki) and further in view of U.S. Pat. Appln. Pub. No. 2002/0072544 (Miller). Applicants respectfully traverse the basis for this rejection because the Office Action has presented a *prima facie* case of obviousness. In particular, one of ordinary skill in the art would not have combined Ansmann with Yamasaki or Miller.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), viz., (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. See *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Furthermore, although the analysis need not identify explicit teachings directed to the claimed subject matter, “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385, 1396 (2007). As such, “there must be some articulated reasoning with some rational underpinning to support the legal

conclusion of obviousness.” *Id.* (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)).

Ansmann is directed to an oil-in-water emulsion which includes a wax dispersion. As noted by the Office Action, Ansmann discloses wax dispersions that may include a dialkylene carbonate. The Office Action admits that Ansmann fails to teach or suggest a melting point of the wax or a particle size. Yamasaki is relied upon for its disclosure of a stick-type solid water-in-oil type emulsion that happens to remain solid over a temperature range of 0 to 50°C. Without providing any actual motivation to combine and using purely hindsight, the Office Action concludes that

“... it would have been obvious to one of ordinary skill in the art at the time of the invention to ensure the emulsion as taught by Ansmann has a melting point as taught by Yamasaki so the Ansmann emulsion easily melts on the skin and spreads over the skin smoothly.”

(Office Action at page 4). The combination of Ansmann with Yamasaki is improper because one skilled in the art of wax dispersions (i.e., oil-in-water emulsions) starting with Ansmann would not look to Yamasaki for guidance on melting points of materials because Yamasaki is directed to entirely different emulsions of solid water-in-oil emulsions. What is appropriate as a melting/solidification point for a solid stick product (Yamasaki) is simply not informative of what is suitable for an oil-in-water emulsion such as Ansmann. In view of these disparate emulsions, the Office Action fails to provide a rationale basis for the combination of Ansmann and Yamasaki.

As to particle size, the Office Action turns to Miller, which discloses in its background a discussion of particle sizes in liquid/liquid water-in-oil fine emulsions and macroemulsions. According to the Office Action,

“[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to ensure the dispersion as taught by Ansmann and Yamasaki comprises particles sizes in the range as taught by Miller so upon heating there will be no phase separation or sedimentation of the dispersed substances.”

(Office Action at page 4). The combination is improper because one skilled in the art of wax dispersions (i.e., oil-in-water emulsions) starting with Ansmann would not look to Miller which

is directed liquid-liquid emulsions. What is appropriate as a particle size for liquid-liquid emulsions (Miller) is not informative of what is suitable for an oil-in-water emulsion having wax particles (Ansmann).

Accordingly, it appears that the Examiner has chosen materially different references, and there is no motivation to combine these references. It is only through the improper use of hindsight that the references have been combined by the Examiner. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1443 (Fed. Cir. 1983) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”).

Reconsideration and withdrawal of the 35 U.S.C. 103(a) rejection of claims 24, 26, 28-38, 40-43 and 51-52 are requested.

Claims 44-49

Claim 44-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann in view of Yamasaki and further in view of Miller as applied to claim 24 and further in view of U.S. Patent No. 4996004 (Bucheler). Applicants respectfully traverse this basis for rejection. For at least the reasons discussed above, there is no rational basis to support the combination of Ansmann, Yamakai, and Miller. The addition of Bucheler, directed to “preparation of pharmaceutical or cosmetic dispersions,” fails to make-up for the deficiency in the combination of the other references.

Reconsideration and withdrawal of the 35 U.S.C. 103(a) rejection of claims 44-49 are requested.

CONCLUSION

It is believed that claims 24, 26, 28-38, 40-49, and 51-52 are now in condition for allowance, early notice of which would be appreciated. No fees are believed due with this submission. If any fees are due at this time, the Commissioner is authorized to charge Deposit Account No. 50-3329. Please contact the undersigned if any further issues remain to be addressed in connection with this submission.

Respectfully submitted,

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